

REMARKS

Reconsideration of this application is respectfully requested.

The courtesy of the Examiner in explaining the 25 U.S.C. § 112 sixth paragraph problem in a telephonic interview this date is sincerely appreciated. In a brief summary of our telephone conference, it is my understanding that it is now deemed improper to use an adjective before "means" in a claim when the "means" is first positively recited. However, in further recitation of the same "means" it is deemed proper to use an adjective term before "means" in both the claim where the "means" is first recited and in following claims in order to prevent having to recite the entire function.

With the above understanding, independent claims 1 and 27 have been canceled and independent claims 31 and 32 have been newly presented to replace the canceled independent claims.

Claims 2 - 26 and 27 - 30 are all dependent claims, dependent respectively on the newly presented independent claims. With the change in "means" verbiage, and the change in independent claim numbering, most of the dependent claims have also been amended. However, the amendments to the dependent claims has not changed any of the limitations originally found in the dependent claims.

Original claim 27 was deemed allowable, and with the allowance of claim 27, claims 28 - 30 were also deemed allowable. Accordingly, it is respectfully submitted that claims 32 and 28 - 30 as now presented are allowable.

The indication of allowability of all but 5 claims in the application is duly noted. Again, Whitfield '421 is the primary reference of record. The five rejected claims are independent claim 1 and dependent claims 4, 13, 16, and 17. If claim 1 (now claim 31) is deemed allowable, then it follows that all of its dependent claims are also allowable.

The major problem remains the interpretation of original claim 1, now claim 31, with respect to the Whitfield '421 patent.

Claim 31, the only independent claim under rejection, recites 5 "means plus function" elements now believed to fully comply with the latest PTO philosophy of 35 U.S.C. § 112, sixth paragraph. The five means plus function elements are sometimes abbreviated in the following discussion.

The first means is "perimeter structural support means."

The term "perimeter" is used in the specification in its ordinary, every day, dictionary meaning, namely "the outer boundary of a figure or area." See Webster's New World Dictionary, Second College Edition, 1980, or any dictionary. The definition of "perimeter" has not changed, to the best of the undersigned's understanding, in recent years to mean anything but the way the term has been defined in the cited dictionary. A 1989 dictionary has also been consulted and the definition is substantially the same.

The Examiner states that the four corner posts 2 of Whitfield '421 comprise the perimeter support means. The four corner posts do not in any way extend over the perimeter of the Whitfield structure. There is nothing in the present specification to

indicate that the perimeter structural support means is only located at the corners of a structure or area, and there is nothing in any definition of the term "perimeter" that would allow such interpretation as the Examiner has consistently held. There is nothing in the specification or drawing figures in the present application that allows four corner posts to comprise a perimeter structural support for the present invention.

The second means is "holding means for holding run off water secured to the perimeter structural support means."

The Examiner states that the side walls 3 comprise the liner means.

Actually, by adding the four side plates 3 to the four corner posts, a perimeter support is provided to the Whitfield patent that comes closer to perimeter support of the present structure than the four corner posts themselves.

However, when one uses the side plates along with the corner posts, then what is the liner means which is defined as being secured to the perimeter support means?

The third means is "means for draining run off water onto the holding means."

The Examiner interprets the drain pipe 13 of Whitfield's Fig. 7 as the equivalent structure to the "means for draining water onto the holding means." According to the Whitfield specification, the drain pipe 13 is for draining water away from a catch basin. In actuality, the Whitfield drawing does not have the reference numerals 13 and 14 in any of the drawing figures. Reference numeral 15 is shown in Fig. 7, and the specification states that the drain pipe 15 is the lowest of the drain pipes. See column

2, lines 41 - 67. Apparently the Examiner uses one pipe from one unit to comprise the "draining onto" element and another pipe from a unit to comprise the "draining... from" element. No matter how the Examiner analyzes the structure of Whitfield, it apparently requires two units for the draining onto and the draining off elements!

The fourth means is "means for draining the run off water from the holding means."

Again, see column 2, lines 41 - 67 for a description of the Whitfield pipes which drain water from one catch basin to the next lower catch basin.

There is no structure in the present invention that requires a plurality of underground water retention units to be connected in series as is shown and described in the Whitfield '421 patent.

The fifth means is the "roof means" disposed on the perimeter structural support means.

The Examiner states that the top 5 of Whitfield is the equivalent of the "roof means" of the present invention. The top 5 is disposed on the four corner posts and the side walls of the Whitfield structure. Then the top 5 receives a grate through which water drains into the Whitfield structures. The grate is not identified by a reference number, but is only inferred by comments in the specification, and three grates are shown in Fig. 7. The top 5, with its grate, in actuality comprises what may be construed as structure paralleling the third means set forth above, the "means for draining

run off water onto the liner means,” although the roof means in the present invention is defined as also to be used for other appropriate uses. A parking lot is such a use.

The problem with the Examiner’s analysis is simply that the small plastic catch basin of Whitfield is not comparable to the present invention. The Whitfield structure does not have equivalent elements to the five elements set forth in claim 1.

If the Examiner attributes several different functions to the Whitfield elements, then the relationship of the elements set forth in claim 1 fail. For example, if the perimeter support means includes both the four corner posts and the four side walls, then what comprises the holding means secured to the perimeter support means? In other words, can the side walls be both perimeter structural support means and the holding means secured to itself???

The liner means is secured to the perimeter support means, but the function for the holding means is stated as “for holding a quantity of run off water.” There are two different structures and two different functions in the present invention. Again, the comparison between Whitfield and the present invention fails.

If the roof means of Whitfield comprises the top 5, what is the “appropriate usage of the roof means” in Whitfield? There already has been defined “means for draining run off water onto the liner mean.” Attributing that function again is obviously redundant. Again, the comparison between Whitfield and the present invention fails.

The Examiner has stated that there is nothing in the claims that precludes the four corner posts from being the perimeter support and that the side plates from being the holding means. The attention of the Examiner is again directed to the language of the claims, as well as to the arguments set forth clearly above, in the Appeal Brief, and in the Remarks portions of the previous responses to the same rejection based on Whitfield '421. Nothing in the claims, in the specification, or in the drawing figures, in any way indicates that the perimeter support elements extend only part way around the perimeter of the structure, let alone at only the four corners. The term "perimeter" means extending about the boundary of the structure. There is no justification found in the specification, claims, drawing figures, or logic, that allows four corner posts to be considered as perimeter structural supports!!!

With respect to the newly cited Zimmerman patent, the Examiner has cited it for a showing of a submersible pump in the rejection of claim 4. Claim 4 recites a submersible pump as part of the means for draining water from the liner means. The submersible pump in Zimmerman is used to drain water from a wet well, not from "liner means." The wet well of Zimmerman is more nearly comparable to the dry wells to which the run off water drains into from the holding means of the present invention. Accordingly, Zimmerman is not a proper reference.

And, perhaps more appropriately, how would the Examiner combine Zimmerman's submersible pump with the Whitfield structure. There isn't any indication

in the two patents that such combination may be made. The courts have long indicated that there must be an indication of combining references under 35 U.S.C. § 103. Such indication is absolutely lacking in the two patents. Merely pulling a submersible pump out of thin air is improper, and that is essentially what the Examiner has done.

With respect to claim 13, note that three different side wall portions are positively recited. These limitations refer to what is best illustrated in Figs. 3, 5, 8, and 9 in which three distinct side wall portions are illustrated and discussed in the specification beginning on page 8 and in the following pages. There are not three distinct side wall portions in either reference cited in the latest Office Action. With three distinct side wall portions positively recited, based on structure clearly illustrated and discussed, it is improper to merely state that a vertical wall may be divided arbitrarily into three portions to fit the claimed structure. The rejection of claim 13, separate and apart from the rejection of claim 1, is accordingly improper and should be withdrawn.

The Examiner asks why applicant's interpretation is considered to be the only valid one. The answer is simply that the language of the specification and claims has been carefully set forth to describe and claim the invention in such clear and concise terms as to enable one of ordinary skill in the art to make and use the invention. Each term is used in the typical and ordinary usage of the terms. Again - for example, the term "perimeter" means just that, extending about the boundary of the structure. The term

"perimeter" does not and cannot mean four corner posts by any stretch of the imagination.

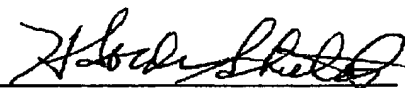
For the reasons set forth above, it is respectfully submitted that all of the claims in the application are allowable as defining over the cited art.

A Notice of Allowance is accordingly respectfully urged.

If the Examiner would prefer language other than is now found in the claims, the undersigned would appreciate a telephone call on order to expedite the prosecution of this application.

Respectfully submitted,

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